

Title: GOLF CLUB HEAD HAVING A BI-POLYMER FACE INSERT AND METHOD OF MAKING SAME

Serial No. 10/764,024

Amendment

### REMARKS

Claims 1-17 were pending in the application. Claims 18 and 19 are added by this amendment. Accordingly, claims 1-19 are now pending in the application.

Claims 1-3, and 15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,924,939 to Grace, et al. Applicants have amended claims 1 and 15 to overcome the rejection. Grace discloses a golf club head having a first face insert within a second face insert in which the first face insert has projections forming "indicia" (e.g. logos or letters forming the manufacturer's name) that fit into corresponding recesses in the second face insert. Since Grace discloses and teaches multiple letter or logo shaped recesses in the second face insert, Grace does not disclose a second face insert having a *planar* recess that is shallower than it is wide, as claimed in claim 1 as amended. Similarly, Grace does not disclose a first face insert that is prevented by the side walls of the second face insert from coming into contact with the recess in the club head body as claimed in claim 15. [See Figs. 1 and 2 of Grace] Accordingly, Grace does not anticipate claims 1-3 and 15 as amended.

Claims 2, 4-6, 16 and 17 are rejected under 35 U.S.C. § 103(a) as being obvious considering Grace in view of U.S. Patent No. 6,729,972 to Board. As noted above, Grace discloses a golf club head having a first face insert that has projections forming "indicia" that fit into corresponding recesses in the second face insert. Since the purpose of the projections and corresponding recesses are to provide a visual effect, preferably the first and second face inserts are formed of the same material, except for color. [Col. 2, lns. 23-28]. Accordingly, Grace does not teach any advantage to be gained by using a different material for the first and second face inserts. In fact, since the "indicia" are likely to be irregularly shape, it would be counter to good

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practice to make the first and second face inserts from different materials, as this would adversely affect the consistency of the club face response. Moreover, since the visual effect of the matched face inserts of Grace is derived from machining the second face insert so that the projections on the first face insert extend completely through the corresponding recesses in the second face insert [Col. 2, ln. 64- Col. 3, ln.7], modifying Grace to have a planar recess in the second face insert would render Grace unsuitable for its intended purpose. A planar recess would render it impossible to machine away the second face insert to expose the projections without exposing the entire first face insert. Accordingly, applicants urge that the claims, as amended, are not rendered obvious under § 103 by any suggested combination that includes Grace.

Additionally, with respect to claims 10-17 and new claims 18-19, although Boord discloses a laminated insert comprising two different materials, nothing in Boord discloses or suggests the second insert being fully surrounded on its lateral sides by the first insert. As noted in the specification of the present application, the cup-shaped recess in the face insert permits use of silicone gels and other semi fluid materials as the cavity insert material, while still permitting the cavity insert to be assembled to the face insert before the face insert is bonded to the club head recess. Accordingly, for this additional reason, applicants urge that claims 1-19 are allowable over the combination of Grace and Boord suggested by the examiner.

Claims 7-9 stand rejected as obvious considering Grace in view of U.S. Patent No. 6,425,831 to Heene. For the reasons discussed above, applicants urge that since any suggested combination that would modify Grace to include a planar recess in the second face insert, as claimed in the claims as amended, would render Grace unsuitable for its intended purpose and

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therefore the claims are allowable over Grace. According, applicants urge that claims 7-9, as amended, are allowable over the suggested combination of Grace and Heene.

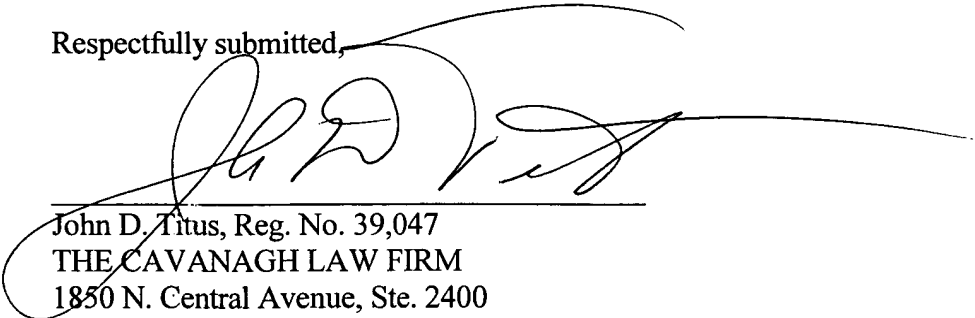
Claims 10-14 stand rejected as obvious considering the of Grace, in view of Boord and U.S. Patent No. 6,425,831 to Heene. Applicants respectfully urge that for the reasons discussed above with respect to the suggested combination of Grace and Boord, that since claims 10-14 are allowable over any combination that would render the invention of Grace unsuitable for its intended purpose and nothing in Boord suggests the advantages to be gained by use of a cup-shaped recess, claims 10-14 are allowable over the suggested combination of Grace, Boord and Heene.

Conclusion

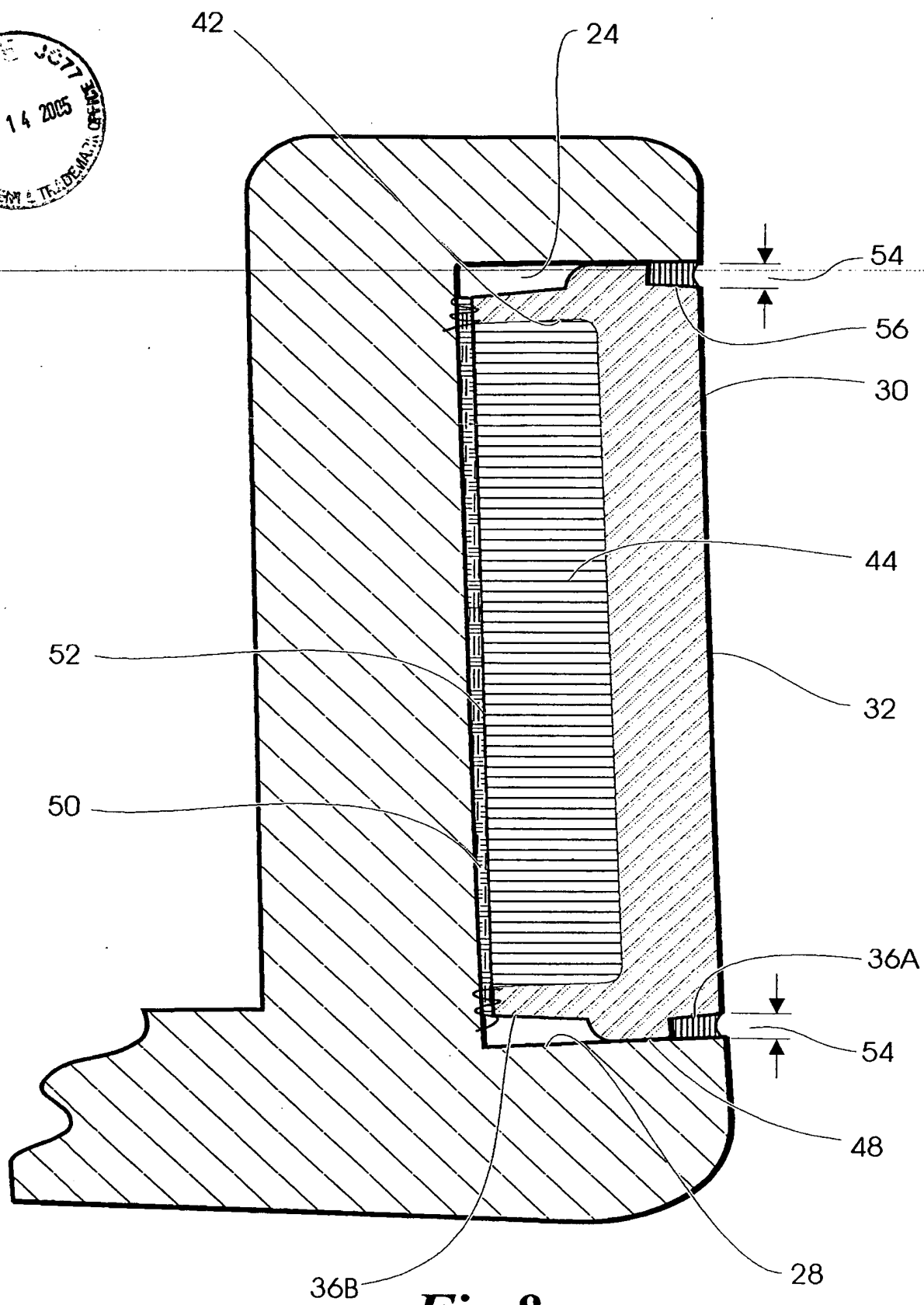
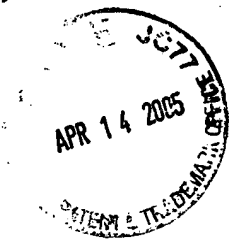
No new matter is introduced by the amendments herein. Support for the amendments to the specification and drawings is found in the specification at page 4, lines 9-11 and at page 4, lines 14-17. Based on the foregoing, applicants believe that all claims under consideration are in a condition for allowance and reconsideration of this application is respectfully requested.

Respectfully submitted,

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**Fig.8**